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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,131	09/16/2003	Jesse D. Crum	WK/2003-05/US	3994
7590 12/23/2005			EXAMINER	
WARD KRAFT, INC.			DICUS, TAMRA	
P.O. BOX 938			ART UNIT	
FORT SCOTT, KS 66701			PAPER NUMBER	

1774

DATE MAILED: 12/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/663,131

Applicant(s)

CRUM, JESSE D.

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 20-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 20-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The claim objection is withdrawn due to Applicant's amendments. Claims 4, 13, 10 and 26-27 rejection under 112 2nd paragraph is withdrawn due to Applicant's amendments. The cancellation of claims 16-19 and 29-32 are acknowledged.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The Examiner believes that independent claim 1 (amended) does not have the proper support in the original specification as filed because the specification does not provide any teaching or discussion on patterns of material rise from a surface and an amount substantially equal or its usage with Applicant's claimed business form.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- Claims 1 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 1 recites the limitations “an amount substantially equal” and Claim 20 recites the second thickness “substantially equal”. The terms “an amount substantially equal” and “substantially equal” are indefinite as the specification does not provide a definition to the metes and bounds of the phrase. In order to determine infringement of the present claims, one necessarily would need to determine with a reasonable degree of certainty the scope of the phrase “substantially the same.” Applicant has failed to provide any such guidance and, accordingly, this phrase renders the scope of the claims unclear.

When a term of degree is presented in a claim, first a determination is to be made as to whether the specification provides some standard for measuring that degree. If it does not, a determination is made as to whether one of ordinary skill in the art, in view of the prior art and the status of the art, would be nevertheless reasonably apprised of the scope of the invention. Even if the specification uses the same term of degree as in the claim, a rejection may be proper if the scope of the term is not understood when read in light of the specification. While, as a general proposition, broadening modifiers are standard tools in claim drafting in order to avoid reliance on the doctrine of equivalents in infringement actions, when the scope of the claim is unclear a rejection under 35 U.S.C. 112, second paragraph is proper. See *In re Wiggins*, 488 F. 2d 538, 541, 179 USPQ 421, 423 (CCPA 1973). Additionally, a substantial portion was held to be indefinite because the specification lacked some standard for measuring the degree intended and, therefore, properly rejected as indefinite under 35 U.S.C. 112, second paragraph. *Ex parte Oetiker*, 23 USPQ2d 1641 (Bd. Pat. App. & Inter. 1992).

Claim 10 is not clear due to the limitation, “first and substrates”.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15 rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,340,512 to Mercer et al. in view of UPSN 4,627,994 to Welsch.

Mercer essentially teaches the claimed invention.

While Mercer teaches removable labels and having a form in continuous roll form or stack arrangement (col. 3, line 65-col. 4, line 5), Mercer does not explicitly teach the removable card labels are self-laminating.

Welsch teaches a continuous business form including self-laminating labels (pressure sensitive adhesive) (48, FIG. 2 and associated text), which construction aids in adhering of the label preventing wrinkling while in a folded stack or roll form of continuous sheets.

It would have been obvious to one having ordinary skill in the art to have modified the form of Mercer to employ self-laminating labels because Welsch teaches the labels may be removed by peeling from the form and aids in adhering of the label preventing wrinkling while in a folded stack or roll form of continuous sheets (Abstract, FIG. 1-2, col. 2, lines 5-55, col. 3, lines 1-20, col. 3, lines 65-68, and col. 4, lines 60-68). The combination of prior art thus produces the instant invention as claimed.

Claims 1-7, 11-14, 20, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,340,512 to Mercer et al.

Mercer teaches a business form (10, FIG. 1) with removable, joined, and adjacent integrated cards/labels of paper or cardstock (18 and 20, FIG. 1 and associated text, first and second removable substrates having a property), having a plurality of patterns forming leveling aids spaced apart (tape patches 28, 50, and 26, FIG. 1 and associated text) that connects and adjoins two said removable substrates. The patterns are composed of segmented strips comprised of adhesive tape, resinous material, or cellophane (col. 3, line 14-15, col. 3, line 28-30). Claims 1-6, 10 and 13-14 (see also col. 4, lines 5-30, col. 2, lines 65-68) are met.

Claim 7 is met as the Figures show a substantially square shape, and that it has a square shape when placed in a stack naturally occurs is suggestive and does not limit the claim.

Regarding claim 10, at least one pattern is disposed on the first substrate (indicia printed on 18 and 20, FIG. 2 and associated text).

Claim 11, the strips may be provided with indicia (col. 4, lines 20-23).

Claim 12, the surface affinity effect is inherent as the same materials and structure is provided.

Regarding claims 20 and 23, Mercer teaches removable labels and having a form in continuous roll form or fan-folding arrangement (col. 3, line 65-col. 4, line 5). Further, Mercer teaches a business form (10, FIG. 1) with removable, joined, and adjacent integrated cards/labels of paper or cardstock (18 and 20, FIG. 1 and associated text, first and second removable substrates having a property), having a plurality of patterns spaced apart (tape patches 28, 50, and 26, FIG. 1 and associated text) that connects and adjoins two said removable substrates. The patterns are composed of segmented strips comprised of adhesive tape, resinous material or

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cellophane (col. 3, line 14-15, col. 3, line 28-30). (see also col. 4, lines 5-30, col. 2, lines 65-68) are met.

To claim 22, at least one pattern is disposed on the first substrate (indicia printed on 18 and 20, FIG. 2 and associated text) and the strips may be provided with indicia (col. 4, lines 20-23).

Further to claims 1 and 20, Mercer does not explicitly define the thicknesses or rising amount of the label, patterns to form leveling aids, and form, however, it would have been obvious to one having ordinary skill in the art to have different thicknesses because Mercer teaches the card label is of paper, cardstock or plastic cut into any shape or size (col. 2, lines 65-68) and teaches it is the card and form (the patterns including forming leveling aids are on the form) thickness is an optimizable feature so as to avoid unnecessary bulk (col. 1, lines 50-68). It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272. Thicknesses of all the label, patterns, and forms effects the way the continuous forms feed through the printer and the strength.

Claims 24 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,340,512 to Mercer et al. in view of UPSN 4,627,994 to Welsch.

Mercer teaches removable labels and having a form in continuous roll form or fan-folding arrangement (col. 3, line 65-col. 4, line 5). Further, Mercer teaches a business form (10, FIG. 1) with removable, joined, and adjacent integrated cards/labels of paper or cardstock (18 and 20, FIG. 1 and associated text, first and second removable portions), having a plurality of patterns spaced apart forming a leveling aid (tape patches 28, 50, and 26, FIG. 1 and associated text) that connects and adjoins two said removable portions. The patterns are composed of

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segmented strips comprised of adhesive tape, resinous material or cellophane (col. 3, line 14-15, col. 3, line 28-30). At least one pattern is disposed on the first substrate (indicia printed on 18 and 20, FIG. 2 and associated text) and the strips may be provided with indicia (col. 4, lines 20-23). Claims 24, 28, and 26 are met (see also col. 4, lines 5-30, col. 2, lines 65-68).

To claim 27, the surface affinity effect is inherent as the same materials and structure is provided.

Further to claim 24, Mercer does not explicitly define the thicknesses of the label and form as different, however, it would have been obvious to one having ordinary skill in the art to have different thicknesses because Mercer teaches the card label is of paper, cardstock or plastic cut into any shape or size (col.2, lines 65-68) and teaches it is the card and form thickness is an optimizable feature so as to avoid unnecessary bulk (col. 1, lines 50-68). It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272. Thickness effects the way the continuous forms feed through the printer.

Further to claim 24, Mercer does not explicitly define the form as a stack, while stating the form is in roll or fan-folding form.

Welsch teaches a continuous business form including self-laminating labels (pressure sensitive adhesive) (48, FIG. 2 and associated text), which construction aids in adhering of the label preventing wrinkling while in a folded stack or roll form of continuous sheets.

It would have been obvious to one having ordinary skill in the art to have modified the form of Mercer to employ a stack consisting of 10 to 10,000 assemblies because Welsch teaches a folded stack or roll form of continuous sheets are equivalents and may contain a variety of

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individual forms as illustrated (Abstract, FIG. 1, col. 2, lines 5-55, col. 3, lines 1-20, col. 3, lines 65-68, and col. 4, lines 60-68).

Claims 8-9 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,340,512 to Mercer et al. in view of USPN 6,830,795 to Downs.

Mercer essentially teaches the claimed invention as applied to claims 1 and 20 above.

Mercer does not expressly teach a business form having the pattern stripes selected from wax or silicone coatings (claims 8 and 21) or having a roughened surface (claim 9).

Downs teaches labels used in various carriers such as envelopes and parcels for identification a multilayered adhesive stripes (126, 130, 134, FIG. 1-4) having a coating of wax or silicone (106, 114, 120, FIG. 1-4) on top to aid in easy release when labels are in a stack and a plurality of labels are used in a roll or stack (FIG. 1 and 2). See further col. 1, lines 5-10 and col. 4, lines 20-35.

It would have been obvious to one having ordinary skill in the art to have included wax or silicone to the stripes of Mercer because Downs teaches multilayered adhesive stripes having a coating of wax or silicone on top to aid in easy release when a plurality of labels are in a stack or used in a roll or stack (FIG. 1-4 and col. 4, lines 20-35 of Downs). That the stripes have a roughened surface would be expected because the same material, pattern, and indicia print are applied to the stripes as taught by the prior art.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,340,512 to Mercer et al. in view of USPN 4,627,994 to Welsch and further in view of USPN 6,830,795 to Downs.

Mercer and Welsch essentially teach the claimed invention as applied to claim 24 above.

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Mercer does not expressly teach a business form having the pattern stripes selected from wax or silicone coatings (claim 24).

Downs teaches labels used in various carriers such as envelopes and parcels for identification a multilayered adhesive stripes (126, 130, 134, FIG. 1-4) having a coating of wax or silicone (106, 114, 120, FIG. 1-4) on top to aid in easy release when labels are in a stack and a plurality of labels are used in a roll or stack (FIG. 1 and 2). See further col. 1, lines 5-10 and col. 4, lines 20-35.

It would have been obvious to one having ordinary skill in the art to have included wax or silicone to the stripes of Mercer and to modify the combination of Mercer and Welsch because Downs teaches multilayered adhesive stripes having a coating of wax or silicone on top to aid in easy release when a plurality of labels are in a stack or used in a roll or stack (FIG. 1-4 and col. 4, lines 20-35 of Downs).

Response to Arguments

4. Applicant's arguments filed 10-17-05 have been fully considered but they are not persuasive.

5. Applicant argues the amended term leveling aid is found in the specification, to which the Examiner agrees, however the Applicant has amended the claims to more than the term leveling aid, as set forth above in regards to the new matter rejection. The Examiner understands the intention to the thickness of the strips forming an offset height differences, however, this intention is not present in the amended claims. Further any thickness change is an obvious modification because it is a result effective variable as set forth above.

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6. Applicant argues Mercer in view of Welsch would increase the thickness and further exacerbate problems created by the thickness differential in the form and may interfere, however, Applicant has not provided evidence such as test results to prove this assertion.

Applicant argues Mercer does not suggest first and second patterns used as leveling aids, however the claim does not provide this limitation and further the leveling aids are defined in the specification (page 11, 0043) as a plurality of patterns, which Mercer explicitly teaches (plurality patterns of tape patches 28, 50, and 26, FIG. 1 and associated text). Further using patterns as leveling aids is not germane to patentability as, it has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

7. In response to applicant's argument that Downs uses release strips and the invention uses strips for purposes of leveling aids, that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Both patterns are in stripes and in Downs the stripes having coatings of silicone which the claim requires and does not teach away, both Mercer and Downs are analogous art and would in combination form the instant invention as previously set forth. Again, Applicant has provided no objective evidence to the opinion that the combination would be inoperable.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamra L. Dicus
Examiner
Art Unit 1774

December 12, 2005



RENA DYE
SUPERVISORY PATENT EXAMINER

A.U. 1774 12/19/05